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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/183,267 10/30/98 GUARNIERI F SAR-12902

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HM12/1206

EXAMINER

MCCARTHY III, T

ART UNIT

PAPER NUMBER

1618

DATE MAILED:

12/06/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

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# Office Action Summary

Application No.  
**09/183,267**

Applicant(s)

**Guarnieri**

Examiner

**McCarthy, T.C.**

Group Art Unit

**1618**



☒ Responsive to communication(s) filed on Oct 30, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire one month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-10 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 1-10 are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## DETAILED ACTION

### *Election/Restriction*

***I. Restriction to one of the following inventions is required under 35 U.S.C. 121:***

- I. Claims 1-8, drawn to a method for conducting simulated identification of binding sites, classified in class 702, subclass 22+.
- II. Claim 9, drawn to a combinatorial process for synthesizing a library of compounds, classified in class 436 or 530, subclass depends on what comprises the library.
- III. Claims 10, drawn to an assay, classified in class 435, subclass 7.1+.

Inventions I and II are different. The steps required to simulate docking of candidate compounds with a target are different from those required to combinatorially synthesize a library of compounds, and the end products are different (i.e. one produces a set of numbers, the other an actual compound). Therefore, art reading on one invention would not read on the other; restriction is proper.

Inventions I and III are different. The steps and reagents required to simulate docking of candidate compounds with a target are different from those required to perform an functional

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binding assay with actual compounds, and the two processes identify different active compounds. Therefore, art reading on one invention would not read on the other; restriction is proper.

Inventions II and III are different. The steps and reagents required to perform assays are different from those required to synthesize a library, and the two processes are practiced for different purposes. Therefore, art reading on one invention would not read on the other; restriction is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper. However, some of the above distinct inventions may fall within the same class and subclass. In these cases, restriction is also proper because of the reasons listed above, and because these inventions have acquired a separate status in the art due to their recognized divergent subject matter.

A telephone call was made to William Burke on November 18 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the

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application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to T.C. McCarthy whose telephone number is (703) 308-5316. The examiner can normally be reached on Monday to Friday from 8:30 am to 5:30 pm.

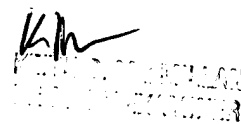
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald E. Adams, can be reached on (703) 308-0570.

The fax phone number for the organization where this application or proceeding is assigned is (703) 308-7924.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

November 18, 1999

T.C. McCarthy III, Ph.D.

A handwritten signature, likely of T.C. McCarthy III, is written over a rectangular official stamp. The stamp contains text that is partially obscured by the signature but appears to include "T.C. MCCARTHY III" and "EXAMINER".